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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/829,414 | 04/09/2001 | Solomon Sundar Manoharan | U 013394-2 | 9001 |

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03/20/2003

EXAMINER

KOSLOW, CAROL M

| ART UNIT | PAPER NUMBER |
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1755

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,414

Applicant(s)

MANOHARAN, SOLOMON
SUNDAR

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Applicant's election with traverse of Group I is acknowledged. The traversal is on the grounds that the search for Group I should reveal all the art relevant to Group II. This is not found persuasive because the search required for Group I is not required for Group II.

The requirement is still deemed proper and is therefore made FINAL.

Claims 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The drawings are objected to because figure 2 does not meet the requirements of 37 CFR 1.84. The micrograph of figure 2 was not developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. The figure contain alterations in the form of the micrograph stapled on the paper. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The disclosure is objected to because of the following informalities:

The phrase "...video tapes as magnetic head heads,.." on pages 1 and 5 is missing either a word or punctuation from between "tapes" and "as". The [in line 7 on page 2 should be deleted.

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On page 3, line 24, "M Ohms" should be MOhms. Finally, the form of the blend is unclear. Page 5, lines 6-8 teaches the polymer and the CrO_2 of the blend are in the form of powders, while the specification teaches the disclosed processes produce the blend. The composition resulting from the processes are in the form of a sheet or film. Thus it is unclear if the blend is the mixture of powders used in the disclosed processes or if the blend is a melted and shaped composition.

Appropriate correction is required.

Claim 1 is objected to because of the following informalities: The phrase "...video tapes as magnetic head heads,.." is missing either a word or punctuation from between "tapes" and "as". Appropriate correction is required.

Claims 3 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no teaching in the specification that the additive is in the form of a powder. While the specification teaches the additive can be carbon black, a conductive carbon powder, this teaching does not support the claim that all additives are powders. There is no teaching in the specification that the melting point of the polymer at 5 Kpa is 95°C . The specification teaches the polymer melts at 95°C and that low density polyethylene melts at 130°C . The taught pressure is used to mold the melted polymer. In the examples, low density polyethylene is melted at 95°C under a pressure of about 5 Tonnes (5000 kilograms) on a 5 mm diameter pellet or about 254.65 kg/mm^2 . This pressure is equivalent to about 2497.26 Mpa. Thus claim 7 is not supported by the specification.

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Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 are indefinite since it is unclear if the blend is the mixture of powders as indicated by claims 3-6, or if the blend is a melted and shaped composition, as indicated but the claimed processes and the teaching in the specification that the processes produce the claimed blend. Claim 1 is indefinite since it is internally inconsistent. The preamble teaches the composition is a CrO₂ polymer composite, but line 6 teaches the composite can contain any magnetic filler. The phrase "magnetic filler preferably" should be deleted. In addition the phrase "preferably" after "polymer" renders claim 1 indefinite because it is unclear whether the limitation following the phrase is part of the claimed invention. See MPEP § 2173.05(d).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proskow.

This reference teaches a magnetic composite of 1-98 wt% CrO₂ powder, 0.3-7 wt% additives of a cross-linking agent and a lubricant and the remainder a polymer. The taught amounts overlap the claimed amounts. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA

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1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed blend.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for Amendments filed under 37 CFR 1.116 or After Final communications is (703) 872-9311. The fax number for all other official communications is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk
March 18, 2003


C. Melissa Koslow
Primary Examiner
Tech. Center 1700